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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 092,652	06 09 1998	KIMHIKO NISHIOKA	PM254750	6330

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EXAMINER

TON, MINH TOAN T

ART UNIT PAPER NUMBER

2871

DATE MAILED 11 29 2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/092.652

Examiner

Toan Ton

Applicant(s)

NISHIOKA ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 40-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 40-70 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1 ☐ Certified copies of the priority documents have been received.  
2 ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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***Election/Restriction***

1. This application contains claims directed to the following patentably distinct species of the claimed invention :

*Independent claims recite alternative languages.*

claim 41 : [41a] the specifics of the device being comprised a diffractive optical element (1st of three possible choices); or [41b] the specifics of the device being comprised a lens element having curved surfaces (2nd of three possible choices); or [41c] the specifics of the device being comprised a mirror and a free curved surface (3rd of three possible choices); or  
and

claim 42 : [42a] the specifics of the device being comprised a diffractive optical element (1st of three possible choices); or [42b] the specifics of the device being comprised a lens element having curved surfaces (2nd of three possible choices); or [42c] the specifics of the device being comprised a mirror and a free curved surface (3rd of three possible choices);  
and

claim 49 recites choosing 3 out of many possible choices. e.g., (1st choice : a display element, a view finder, and an optical surface which is rotationally asymmetrical; 2nd choice : a display element, a view finder, and a diffractive optical element; etc.). Applicant must elect one of the many possible choices.

and

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claim 50 recites choosing 3 out of many possible choices (see possible examples in claim 49 above). Applicant must elect one of the many possible choices.

and

claim 51 recites choosing 3 out of many possible choices (see possible examples in claim 49 above). Applicant must elect one of the many possible choices.

and

claim 52 recites choosing 3 out of many possible choices (see possible examples in claim 49 above). Applicant must elect one of the many possible choices.

and

claim 53 recites choosing 3 out of many possible choices (see possible examples in claim 49 above). Applicant must elect one of the many possible choices.

and

claim 63 recites choosing 2 out of many possible choices, e.g., (1st choice : an image pick up device, a display element; 2nd choice : an image pick up device, a view finder; etc.).

Applicant must elect one of the many possible choices.

and

claim 70 recites choosing 1 out of 8 possible choices. Applicant must elect one of the many possible choices.

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*Dependent claims recite alternative languages.*

claim 54 recites choosing 1 out of many possible choices. Applicant must elect one of the many possible choices;

and

claim 55 recites choosing 1 out of many possible choices. Applicant must elect one of the many possible choices;

and

claim 59 recites choosing 1 out of many possible choices. Applicant must elect one of the many possible choices;

and

claim 64 recites choosing 2 out of many possible choices, e.g., (1st choice : an image pick up device, a display element; 2nd choice : an image pick up device, a view finder; etc.).

Applicant must elect one of the many possible choices.

and

claim 65 recites choosing 1 out of many possible choices. Applicant must elect one of the many possible choices;

and

claim 66 recites choosing 1 out of many possible choices. Applicant must elect one of the many possible choices;

and

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claim 67 recites choosing 1 out of many possible choices. Applicant must elect one of the many possible choices.

*Dependent claims will be properly-grouped in accordance with MPEP once election is made.*

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Contact Information***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. TON whose telephone number is (703) 305-3489. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

November 19, 2001

  
**TOANTON**  
**PRIMARY EXAMINER**